

10 MAY 2007



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In re Application of	:	
NAKAMURA et al.	:	
Application No.: 10/528,069	:	
PCT No.: PCT/JP03/12353	:	
Int. Filing Date: 26 September 2003	:	DECISION
Priority Date: 27 September 2002	:	
Attorney Docket No.: 122733	:	
For: THERMAL TREATMENT APPARATUS,	:	
METHOD FOR MANUFACTURING	:	
SEMICONDUCTOR DEVICE, AND METHOD	:	
FOR MANUFACTURING SUBSTRATE	:	

This decision is in response to the submission filed 16 April 2007 in the United States Patent and Trademark Office (USPTO).

**BACKGROUND**

On 26 September 2003, applicants filed international application PCT/JP03/12353, which designated the United States and claimed a priority date of 27 September 2002. A copy of the international application was communicated from the International Bureau to the USPTO on 08 April 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 28 March 2005 (27 March 2005 being a Sunday).

On 15 March 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a translation of the application into English.

On 26 August 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required.

On 07 October 2005, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a declaration of inventors, a declaration of facts by Mr. Akihiro Fukushima, a copy of a letter sent to non-signing inventor Mr. Shimada on April 6, 2005 and an English translation thereof, a copy of a letter sent to Mr. Shimada on May 23, 2005 and an

English translation thereof, a copy of a letter sent to Mr. Shimada on May 23, 2005 and an English translation thereof, and copies of two certified mail receipts and English translations thereof.

On 03 March 2006, a decision was mailed dismissing applicants' petition under 37 CFR 1.47(a). However, that decision failed to take into account the declaration of facts by Mr. Akihiro Fukushima.

On 13 March 2006, a supplemental decision was mailed vacating the decision mailed 03 March 2006 and taking into account the declaration of facts by Mr. Akihiro Fukushima. The decision dismissed applicants' petition under 37 CFR 1.47(a) without prejudice because applicant had failed to provide factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort. The decision also indicated that a translation of the Figures was required.

On 10 July 2006, applicants filed a submission which was accompanied by, *inter alia*, a declaration of inventors and a translation of the Figures.

On 13 September 2006, a decision was mailed dismissing applicants' petition under 37 CFR 1.47(a) as moot since a 37 CFR 1.497 declaration had been executed by all the joint inventors. The decision also noted that the declaration of inventors filed 10 July 2006 was not in compliance with 37 CFR 1.69(b) and that a pre-approved foreign language declaration in compliance with 37 CFR 1.497(a)-(b) or the requisite statement under 37 CFR 1.69(b) that the translation is accurate was required.

On 16 April 2007, applicants filed the instant submission which includes, a copy of a USPTO receipt date-stamped 27 September 2006 and a copy of a "RESPONSE TO DECISION ON PETITION". The submission has properly been treated as a petition under 37 CFR 1.181.

## **DISCUSSION**

### **Petition Under 37 CFR 1.181**

Applicant has provided sufficient evidence to establish that on 27 September 2006 applicant filed a "RESPONSE TO DECISION ON PETITION". The proof is in the form of the copy of the receipt for the above-identified application which bears a United States Patent and Trademark Office date stamp of 27 September 2006 and which itemizes, *inter alia*, a "RESPONSE TO DECISION ON PETITION". This postcard receipt also identifies the above-captioned application number and attorney docket number. Further, practitioner states that the copy of the "RESPONSE TO DECISION ON PETITION" filed 16 April 2007 is a true copy of the "RESPONSE TO DECISION ON PETITION" originally filed 27 September 2006. Therefore, in view of the date-stamped receipt and practitioner's statement, it is proper to accept the copy of the "RESPONSE TO DECISION ON PETITION" as having been originally filed in the USPTO on 27 September 2006.

Response to Decision (Filed 27 September 2006)

It is urged that 37 CFR 1.69(b) does not apply to the declaration of inventors filed 10 July 2006. 37 CFR 1.69(b) states

Unless the text of any oath or declaration in a language other than English is in a form provided by the Patent and Trademark Office or in accordance with PCT Rule 4.17(iv), it must be accompanied by an English translation together with a statement that the translation is accurate, except that in the case of an oath or declaration filed under § 1.63, the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation.

Applicants urge that the phrase “in a language other than English” applies exclusively to declarations that are “wholly in a foreign language”. However, there is simply nothing in the Rule which limits the language of the declaration to be *only* in a language other than English. Indeed, the rule refers to “a form provided by the Patent and Trademark Office”. The forms provided by the USPTO, e.g., PTO/SB/106 “Japanese Language Declaration”, include both a language other than English, e.g., Japanese, and English. (Attention is also directed to 1287 OG 67, 12 October 2004, “Section 1.69: Section 1.69(b) is amended by deleting the words “or approved” as unnecessary, and possibly leading to confusion and the mistaken assumption that the Office has a procedure for the approval of applicant-generated forms, where no such procedure exists. See Changes to Implement the Patent Business Goals, 64 FR 53771, 53777 (Oct. 4, 1999), 1228 Off. Gaz. Pat. Office 15, 20 (Nov. 2, 1999) (proposed rule) (declining to adopt a review service for applicant-created forms).”)

The statement included with the submission filed 27 September 2006 that the translation of the declaration is accurate satisfies 37 CFR 1.69(b).

**CONCLUSION**

The petition under 37 CFR 1.181 is **GRANTED** for the reasons set forth above.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including the accordation of a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4) date of **10 July 2006**.



Daniel Stemmer

Legal Examiner

PCT Legal Affairs

Office of Patent Cooperation Treaty

Legal Administration

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Enc.: Form PTO/SB/106 “Japanese Language Declaration”

## Declaration and Power of Attorney for Patent Application

## 特許出願宣言書及び委任状

## Japanese Language Declaration

## 日本語宣言書

私は、以下に記名された発明者として、ここに下記の通り宣言する：

As a below named inventor, I hereby declare that:

私の住所、郵便の宛先そして国籍は、私の氏名の後に記載された通りである。

My residence, post office address and citizenship are as stated next to my name.

下記の名称の発明について、特許請求範囲に記載され、且つ特許が求められている発明主題に関して、私は、最初、最先且つ唯一の発明者である（唯一の氏名が記載されている場合）か、或いは最初、最先且つ共同発明者である（複数の氏名が記載されている場合）と信じている。

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

上記発明の明細書はここに添付されているが、下記の欄がチェックされている場合は、この限りでない：

the specification of which is attached hereto unless the following box is checked:

☐ \_\_\_\_\_ の日に出願され、  
この出願の米国出願番号またはPCT国際出願番号は、  
\_\_\_\_\_ であり、且つ  
\_\_\_\_\_ の日に補正された出願（該当する場合）

☐ was filed on \_\_\_\_\_  
as United States Application Number or  
PCT International Application Number  
\_\_\_\_\_ and was amended on  
\_\_\_\_\_ (if applicable).

私は、上記の補正書によって補正された、特許請求範囲を含む上記明細書を検討し、且つ内容を理解していることをここに表明する。

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

私は、連邦規則法典第37編規則1.56に定義されている、特許性について重要な情報を開示する義務があることを認める。

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56.

## Japanese Language Declaration (日本語宣言書)

私は、ここに、以下に記載した外国での特許出願または発明者証の出願、或いは米国以外の少なくとも一国を指定している米国法典第35編第365条(a)によるPCT国際出願について、同第119条(a)-(d)項又は第365条(b)項に基づいて優先権を主張するとともに、優先権を主張する本出願の出願日より前の出願日を有する外国での特許出願または発明者証の出願、或いはPCT国際出願については、いかなる出願も、下記の枠内をチェックすることにより示した。

I hereby claim foreign priority under Title 35, United States Code, Section 119(a)-(d) or 365(b) of any foreign application(s) for patent or inventor's certificate, or 365(a) of any PCT International application which designated at least one country other than the United States listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or PCT International application having a filing date before that of the application for which priority is claimed.

Prior Foreign Application(s)

外国での先行出願

Priority Not Claimed

優先権主張なし

(Number)  
(番号)(Country)  
(国名)(Day/Month/Year Filed)  
(出願日/月/年)(Number)  
(番号)(Country)  
(国名)(Day/Month/Year Filed)  
(出願日/月/年)

私は、ここに、下記のいかなる米国仮特許出願についても、その米国法典第35編第119条(e)項の利益を主張する。

I hereby claim the benefit under Title 35, United States Code, Section 119(e) of any United States provisional application(s) listed below.

(Application No.)  
(出願番号)(Filing Date)  
(出願日)(Application No.)  
(出願番号)(Filing Date)  
(出願日)

私は、ここに、下記のいかなる米国出願についても、その米国法典第35編第120条に基づく利益を主張し、又米国を指定するいかなるPCT国際出願についても、その同第365条(c)に基づく利益を主張する。また、本出願の各特許請求の範囲の主題が、米国法典第35編第112条第1段に規定された態様で、先行する米国出願又はPCT国際出願に開示されていない場合においては、その先行出願の出願日と本国内出願日またはPCT国際出願日との間の期間中に入手された情報で、連邦規則法典第37編規則1.56に定義された特許性に関わる重要な情報について開示義務があることを承認する。

I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s), or 365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of Title 35, United States Code Section 112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56 which became available between the filing date of the prior application and the national or PCT International filing date of application.

(Application No.)  
(出願番号)(Filing Date)  
(出願日)(Status: Patented, Pending, Abandoned)  
(現況: 特許許可、係属中、放棄)(Application No.)  
(出願番号)(Filing Date)  
(出願日)(Status: Patented, Pending, Abandoned)  
(現況: 特許許可、係属中、放棄)

私は、ここに表明された私自身の知識に係わる陳述が真実であり、且つ情報と信ずることに基づく陳述が、真実であると信じられることを宣言し、さらに、故意に虚偽の陳述などを行った場合は、米国法典第18編第1001条に基づき、罰金または拘禁、若しくはその両方により処罰され、またそのような故意による虚偽の陳述は、本出願またはそれに対して発行されるいかなる特許も、その有効性に問題が生ずることを理解した上で陳述が行われたことを、ここに宣言する。

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

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## Japanese Language Declaration (日本語宣言書)

委任状： 私は本出願を審査する手続を行い、且つ米国特許商標庁との全ての業務を遂行するために、記名された発明者として、下記の弁護士及び／または弁理士を任命する。(氏名及び登録番号を記載すること)

POWER OF ATTORNEY: As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith (list name and registration number).

書類送付先

Send Correspondence to:

直通電話連絡先：(氏名及び電話番号)

Direct Telephone Calls to: (name and telephone number)

唯一または第一発明者氏名

Full name of sole or first inventor

発明者の署名

日付

Inventor's signature

Date

住所

Residence

国籍

Citizenship

郵便の宛先

Post Office Address

第二共同発明者がある場合、その氏名

Full name of second joint inventor, if any

第二共同発明者の署名

日付

Second inventor's signature

Date

住所

Residence

国籍

Citizenship

郵便の宛先

Post Office Address

(第三以下の共同発明者についても同様に記載し、署名をすること)

(Supply similar information and signature for third and subsequent joint inventors.)